

### **REMARKS**

Applicant therefore respectfully requests reconsideration of the application as amended and allowance of the application for the following reasons.

#### **Objections**

It is submitted that the amendments to claims 29, 37 and 43 address the objections.

#### **Rejections under 35 U.S.C. §112, first paragraph**

Applicants respectfully traverse this rejection. Section 2163 of the M.P.E.P. explains the standard to be applied as follows:

There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) ("we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims"). However, as discussed in paragraph I., *supra*, the issue of a lack of adequate written description may arise even for an original claim when an aspect of the claimed invention has not been described with sufficient particularity such that one skilled in the art would recognize that the applicant had possession of the claimed invention. The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature which is not adequately described in the specification and which is not conventional in the art or known to one of ordinary skill in the art.

It is submitted that the examiner has not presented reasoning for why a person of skilled in the art would not recognize in the disclosure a description of the invention as defined by the claims. Simply stating that the examiner has not found support does not meet the burden of explaining why a person of ordinary skill would not recognize would not recognize in the disclosure the description as defined.

Nevertheless, it is submitted that the amendments to claims 37 and 38 render this rejection moot for purposes of these two claims.

Regarding claim 39, it is submitted that this limitation is at least inherently disclosed, if not explicitly so. As the examiner admits, the specification states that the member and the image sheet can be each formed of polyvinyl chloride, which necessarily means that the sheets

are formed from the same material. Furthermore, the examiner's reasoning does not make sense to the undersigned representative. Claim 37 specifies that each material be flexible and indentable. Claim 39 simply specifies an additional limitation on the materials.

Rejection under 35 U.S.C. §112, second paragraph

Applicants continue to disagree with this reasoning for this rejection, and therefore traverse it. Nevertheless, it is respectfully submitted that the forgoing amendments render this rejection moot, except for claim 33. It is submitted that claim 33 is correctly worded. Ink receptive coating 26 is applied to surface 18a of image sheet 18, which may be textured. See p. 7 at line 32 to p. 8 at line 12.

Rejection of Claim 38 as Being Anticipated by U.S. 4,294,460 (Errichiello)

Applicants respectfully traverse this rejection.

The examiner contends, among other things, that inserts 32 and 34 of Errichiello are intrinsically flexible because they can be embossed. The undersigned representative respectfully disagrees for at least two reasons. The passage cited by the examiner implies that the inserts are, in fact, molded. Errichiello explains in column 3, at lines 53-56,

In every instance, a given run of books can be one color or one of a variety of color combinations and individually customized with particular, individualized, embossed, flat or planar lettering, designs, logos, etc. for a particular customer or user by simply changing the mold for the inserts. Similarly, books in school libraries or sold at stores servicing high school students, university or college students, trade school students and the like can have inserts which reflect the name, mascot, seal, or other insignia for any given institution of learning. The most in special molding die costs chargeable to each customer for individualized books would be the die costs for the inserts and for the hereinafter described spine insert, if the latter is also customized.”

Furthermore, to “emboss” means “1: to raise the surface into bosses; *esp*: to ornament with raised work 2: to raise in relief from a surface 3: adorn, embellish.” Websters Ninth New Collegiate Dictionary (Merriam-Webster 1983). It does not necessary follow that embossed requires that the material be flexible and indentable. The definition appears to contemplate any ornamentation raised from a surface, which can be accomplished by molding, sculpting or otherwise.

The examiner also fails to address the limitation that the image sheet includes a printed image, meaning that it includes a coating of ink. The claims have been amended to clarify this point, but not to narrow the scope of the claims. There does not appear to be in Errichiello any mention of the inserts having an image printed them.

For at least this reason, Errichiello cannot anticipate claim 38.

Rejections under 35 U.S.C. §103

Applicants respectfully traverse the rejections of claims 29-38 and 40-44. The rejection of each of these claims is, it is respectfully submitted, premised on the same erroneous reading of Errichiello identified above. Because of these errors, it is submitted that a *prima facie* case of obviousness has not been established for any of these claims.

Conclusion

For at least the forgoing reasons, the prior rejection is in error and the claims as amendment are allowable. For any objection or requirement as to form not addressed, it is submitted that such form or requirement is not necessary to further consideration of the claims and that they therefore be held in abeyance until allowable subject matter is indicated. It submitted that this forgoing reply is a *bona fide* attempt to advance the application to final action.

Applicant hereby authorizes the Commissioner to charge any fees due but not submitted with this paper to Deposit Account No. 07-0153. Please reference Attorney Docket No. 125447-1005.

Dated: July 27, 2009

Respectfully submitted,

By           /Marc A. Hubbard/          

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